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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,593	07/18/2003	Rajeev S. Bhide	LD0338 NP	4312

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EXAMINER	
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ART UNIT	**PAPER NUMBER**
1624	

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/622,593	BHIDE ET AL.	
	Examiner	Art Unit	
	Venkataraman Balasubramanian	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION DETAILED ACTION

Applicants' response, which included cancellation of claims 16-20 and amendment to claism1 and 7-15, filed on 11/15/2005, is made of record. Claims 1-15 are now pending.

In view of applicants' response, all 112 second and first paragraph rejections made in the previous office action have been obviated. However, the following rejections remain.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Hunt et al. WO 00/71129 for reasons of record. To repeat:

Hunt et al. teaches several structurally similar pyrrolotriazine compounds, which include generically compounds, composition and the method of use claimed in the instant claims. See formula I on page 3 and note, given the same core, all variable groups overlap with those of the instant claims. See examples 1-143 shown on pages 25-109. Note when Z = OH, or Cl, the compounds taught by Hunt et al. include these compounds as intermediates.

Applicants' argument to overcome this rejection is not persuasive. Applicants' should not that this rejection is abased on the fact that when XZ is OH or Cl, instant

claims 1 and 2 read on the intermediates taught by Hunt et al. to make the genus of compounds exemplified in examples 1-143.

Hence this rejection is proper and is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt et al., WO 00/71129 for reasons of record.

Hunt et al. teaches several structurally similar pyrrolotriazine compounds, which include generically compounds, composition and the method of use claimed in the instant claims. See formula I on page 3 and note, given the same core, all variable groups overlap with those of the instant claims. See pages 3- 16 for details of the invention and pages 16-25 for the processes of making these compounds. See examples 1-143 shown on pages 25-109. Note example hetero cyclic ring 120 is close to the instant R^{42} and that the point of attachment of such a group can either trough the five or six membered ring is clearly taught in these examples. Also note compounds when Z= N, or NH or when Z is OH or Cl are exemplified.

Instant claims require a specific Z linked to the triazine via a N, O or S. Hunt et al. differs in not exemplifying such compounds.

However, Hunt et al. teaches the equivalency of those compounds exemplified with specific substituents with that generically recited on page 3 and claimed. See formula I and note the definition of Z, R^4 and R^5. Note when R^4 and R^5 choices include several compounds, which are generically claimed in the instant claims.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make pyrrolotriazine compounds variously substituted with, X, Y, Z, R^1, R^2, R^3, R^4, R^5 and R^6 as permitted by the reference and expect resulting compounds (instant compounds) to possess the uses taught by the art in view of the equivalency teaching outline above.

This rejection is same as made in the previous office action except that cancelled claims 16-20 are excluded herein. In addition, "when Z is absent" is replaced with "when Z is OH or Cl are exemplified"

Applicants' traversal to overcome this rejection is not persuasive.

First of all, as pointed out above, Hunt et al generically teaches the instant compounds. Note the definition of ZR^4R^5. Note definition of this group clearly overlaps with instant $ZR^{41}R^{42}$.

Secondly, Hunt et al. teaches several heterocyclic cores including example 120, which is the closest to instant R^{42}. Thus, Hunt et al provides guidance for making ZR4R5= pyrolopyridine core compound and has exemplified Z= OH or Cl as well.

Hence, one trained in the art would be motivated to make pyrrolotriazine compounds variously substituted with, X, Y, Z, R^1, R^2, R^3, R^4, R^5 and R^6 including $ZR^{41}R^{42}$ = pyrolopyridine core, as permitted by the reference and expect resulting compounds (instant compounds) to possess the uses taught by the art in view of the equivalency teaching outline above.

Hence this rejection is proper and is maintained.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 7-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-7, 12 and 16 of copending Application No. 09/573,829. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter embraced in the instant claims overlaps with the stated claims of 09/573,829. Note when Z=O, S, or N, the compounds, composition and method of use taught by the copending application is same as claimed in the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-5 and 7-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 and 16-25 of copending Application No. 10/441848. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter embraced in the instant claims overlaps with the stated claims of 10/441,848. Note when Z=OH or SH and R_6 is NR^7R^8, the compounds, composition and the method of use taught by the copending application is same as claimed in the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-5 and 7-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2

and 4-19 of copending Application No. 10/633,997. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter embraced in the instant claims overlaps with the stated claims of 10/633,997. Note when Z=OH, Cl, O, S, the compounds, composition and method of use taught by the copending application is same as claimed in the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

These provisional double patenting rejections are same as made in the previous office action but are now limited to pending claims. Applicants have differed filing Terminal Disclaimer to overcome these rejections.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (571) 272-0674. If Applicants are unable to reach Mukund Shah within 24-hour period, they may contact James O. Wilson, Acting-SPE of art unit 1624 at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Venkataraman Balasubramanian

Venkataraman Balasubramanian

2/10/2005